

Assignee's Claims

Assignee's independent claims 1, 18, 31 and 46, from one of which all remaining claims ultimately depend, are set forth and discussed above.

Lack of Obviousness

To establish a *prima facie* case of obviousness, three criteria must be met:

- I) the prior art must provide "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill";
- II) there must be a reasonable expectation of success; and
- III) all the claimed limitations must be taught or suggested by the prior art.

DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Each of the above criteria are addressed in turn below, whereby the Assignee demonstrates that the combination of Moss and Bushnell does not render obvious the Assignee's claimed subject matter as the combination does not teach, suggest, or otherwise provide motivation to produce the claimed subject matter. Further, the combination does not provide a reasonable expectation of success. Still further, the combination does not even disclose, teach, and/or suggest all of the claimed subject matter.

I) Moss is discussed in detail above and generally provides a caller identification system (20) that identifies specific caller names from a custom name database (32) if a pre-entered destination number within a common organization has been called. U.S. Patent Application Publication No. 2002/0067816, col. 2, lines 32-45. Otherwise, Moss identifies only the organization's name from a standard name database (30). Id., col. 2, lines 20-24. The destination numbers (24) are pre-entered into service switching point (22) in Moss and trigger queries, via service control point (26) to the appropriate name database (30) or custom name database (32) based on the destination

numbers pre-entered into the service switching point (22). Id., col. 2, lines 20-24 and lines 32-45. Nothing in Moss teaches or suggests that the caller information provided from the standard name database (30) or the custom name database (32) includes enhanced caller information in addition to the standard information provided from such databases. As a result, Moss also necessarily fails to teach or suggest that a subscriber may request the retrieval of such enhanced caller information. Further, the custom name information in Moss is only available in response to a call to a destination number within a common organization, rather than through a server that is accessible, upon request, to subscribers outside a common organization, as is contemplated by Assignee's claims.

Bushnell discloses a caller profile system and method for delivering caller profile information to a called party, whereby the caller establishes what information is deliverable to the called party. Id., Abstract and paragraph [0009]. Bushnell further discloses that "The caller profile may optionally be delivered at another time upon the caller's request." Id. (emphasis added). Bushnell specifically discloses that the caller may create and revise a profile. Id. Bushnell further specifically discloses "Prior to making a call, the caller may select one of several profiles to be delivered with subsequent calls." Id. Still further, Bushnell reiterates that the caller "...create and edit their caller profiles, and to select rules for delivery of their profile to called parties." Id., paragraph [0037]. Thus, while Bushnell describes at length aspects of the caller establishing caller profile information and the rules of delivery thereof to a called party, Bushnell nowhere discloses or suggests that the caller profile information is delivered upon a subscriber's (called party's) request, such as cited in the subject matter of Assignee's independent claims.

Thus, neither Moss nor Bushnell teaches, discloses or suggests a caller identification system whereby enhanced caller information, in addition to standard caller information, is accessible to a subscriber (called party) at the subscriber's request, as cited in the subject matter of Assignee's independent claims. Nor is there any motivation to combine Bushnell with Moss to provide such enhanced caller information at a

subscriber's request since Moss does not provide enhanced caller information, and Bushnell requires caller information be selected at a caller's request. Accordingly, the combination of Moss and Bushnell fail to render obvious the features recited in Assignee's independent claims 1, 18, 31 and 46, from one of which all remaining claims ultimately depend. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 5, 6, 8, 10, 24, 26, 34, 35, 38, 40, 52 and 54 based on the combination of Moss and Bushnell is respectfully requested.

II) Because Moss limits the identification of caller information to standard name or custom name information only, then Moss teaches away from providing the enhanced calling information recited in Assignee's independent claims. Moss therefore also teaches away from a subscriber (called party) requesting such enhanced caller information, as also recited in Assignee's independent claims. Likewise, because Bushnell limits the delivery of caller information to a caller's request, then Bushnell also teaches away from providing enhanced calling information to a subscriber (called party) at the subscriber's request, as cited in Assignee's independent claims.

"A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See*, MPEP at §2145 (X)(D)(1). "It is improper to combine references where the references teach away from their combination." *Id.* at § 2145 (X)(D)(2). If the proposed reference(s) changes the principle of operation of the prior art, then the teachings of the reference are not sufficient to support a *prima facie* case of obviousness. *Id.* at §2143.01.

Moss and Bushnell limit the delivery of caller information to a called party. Moss limits the caller information to standard name or custom name, number, date and time information, without providing even the option of enhanced caller information, whereas Bushnell limits the delivery of caller information to control by caller requests. To provide Moss with enhanced caller information is therefore inapposite to the principles of operation of Moss – that is, to limit the caller information to name or custom name, number, date and time information. Further, to provide Bushnell with a called party

request requirement to deliver caller information to the called party is exactly opposite the principle of operation of Bushnell, which is to use a caller request – not a called party request – to deliver caller information to a called party. Thus, neither Moss nor Bushnell provide any reasonable expectation that their systems or methods could successfully be modified individually, or in combination, to provide the combination of the subject matter cited in Assignee's independent claims, from which all remaining claims ultimately depend.

Thus, the combination of Moss and Bushnell does not render obvious the subject matter of independent claims 1, 18, 31 and 46, from one of which all other claims ultimately depend. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 5, 6, 8, 10, 24, 26, 34, 35, 38, 40, 52 and 54 based on the combination of Moss and Gurbani is respectfully requested.

III) Moss discloses a caller identification system that identifies standard name (30) or custom name (32), number, date and time information of a caller, but fails to teach or suggest a server having caller profiles with enhanced caller information that is accessible at the request of a subscriber (called party), in addition to the standard caller information, as set forth in the subject matter of independent claims 1, 18, 31 and 46. Bushnell discloses a method and system of entering and delivering caller profiles to a called party at the caller's request, but fails to disclose or suggest doing so at the called party's request, as cited in each of Assignee's independent claims. Thus, neither Moss, Bushnell, nor the combination thereof render obvious the subject matter recited in at least Assignee's independent claims 1, 18, 31 and 46, from one of which all remaining claims ultimately depend. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 5, 6, 8, 10, 24, 26, 35, 36, 38, 40, 52 and 54 based on the combination of Moss and Bushnell is respectfully requested.

DUE PROCESS

As discussed above, the pending claims recite features that are not remotely taught or otherwise suggested by Moss, Gurbani, Tannebaum, or Bushnell individually or by any combination thereof. The rejections to date based thereon are thus improper and withdrawal thereof is respectfully requested. Still further, maintaining these rejections is a violation of due process. If any factual support for any of these rejections is to be raised in the future, then a subsequent Office Action is required. Such subsequent Office Action must follow the requirements of MPEP §§ 2131 and/or 2143. Further, such subsequent Office Action cannot maintain the rejection already addressed herein — and may instead ONLY properly present the reasons for the rejection. Further, once a subsequent Office Action properly follows MPEP §§ 2131 and/or 2143 and properly supports a rejection, the Assignees must be given another opportunity to rebut the rejection — *that is, the next office action can NOT be final.* Any other action is a violation of due process. ..

CONCLUSION

Assignee submits that all pending claims are patentable in view of the remarks and amendments made herein. Accordingly, the Assignee respectfully request reconsideration of this application and solicits a prompt Notice of Allowance for all pending claims (claims 1-25, 27-53, and 55-62).

If the Examiner determines that anything further is desirable to place this application in even better form for allowance, the Examiner is invited to contact the Assignee's representative at either of the telephone numbers or address indicated below.

If the Office has any questions, the Office is invited to contact the undersigned at (757) 253-5729 (office), (757) 784-1978 (cellular), or bambi@wzpatents.com.

Respectfully submitted,



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